PATENT

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicants: Mark E. Phillips et al.
Application No.: 09/975,748
Filed: October 10, 2001
Title: SYSTEM AND METHOD FOR MUSICAL PLAYLIST
                SELECTION IN A PORTABLE AUDIO DEVICE

                        Examiner: Marlon T. Fletcher
                        Art Unit: 2837
                        Docket No.: 35073.001
                        Date: April 8, 2008

Attention: Board of Patent Appeals and Interferences
Commissioner for Patents,
P.O. Box 1450,
Alexandria, VA 22313-1450

TRANSMITTAL OF REPLY BRIEF

Sir:

Transmitted herewith in triplicate is the Reply Brief with respect to the Examiner's Answer mailed on March 8, 2008. This Reply Brief is being filed pursuant to 37 CFR 1.193(b) within two months of the date of the Examiner's Answer.

We believe that no fee is required for the filing of this Reply Brief. But, at anytime during the pendency of this application, please charge any fees required or credit any overpayment to Deposit Account No. 50-2976 pursuant to 37 CFR 1.25. Additionally, please charge any fees to Deposit Account No. 50-2976 under 37 CFR 1.16 through 1.21 inclusive, and any other sections in Title 37 of the Code of Federal Regulations that may regulate fees. This notice is being submitted in duplicate.

                        Respectfully submitted,
                        Mark E. Phillips et al.
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In re patent application of:

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REPLY BRIEF UNDER 37 CFR 41.41(a)(1)

Mail Stop Board of Patent Appeals and interferences
P.O. Box 1450
Alexandria, VA 22313-1450

Sir:

In response to the Examiner's Answer dated February 8, 2008, applicant replies as follows:

REAL PARTY IN INTEREST

The real party in interest is Mark E. Phillips, 720 Third Ave., Suite 1100, Seattle, WA 98104.

RELATED APPEALS AND INTERFERENCES

Applicant's representative has not identified, and does not know of, any other appeals of interferences which will directly affect or be directly affected by or have a bearing

on the Board's decision in the pending appeal.

STATUS OF CLAIMS

Claims 1-5 and 7-20 and objected claim 6 are pending in the application. Claims 1-5 and 7-20 and objected claim 6 were finally rejected in the Office Action dated March 15, 2007.

STATUS OF AMENDMENTS

No Amendment After Final is enclosed with this brief. The last Amendment was filed May 4, 2006.

SUMMARY OF CLAIMED SUBJECT MATTER

Independent Claim 1

Claim 1 is directed to a system for the display and control of music selection in a hand-held portable multi-media device (Current Application, page 3, lines 2-9). The system includes: (1) a housing (150 in Figure 2) sized to be held by a user; (2) a circuit board ((Current Application, page 8, lines 8-12) within the housing; (3) a battery power supply (132 in Figure 1) to provide electrical power to electrical circuitry on the circuit board; (4) a data structure (Current Application, page 7, lines 26-28) to store a plurality of music data files, each music selection data file having identification data associated therewith; (5) a display (108 in Figure 2) to display data comprising a playlist (184 in Figure 4) indicating music data files to be played; (6) an input device (110 in Figure 2) operable by the user to select identification data associated with desired music data files for the playlist; (7) a processor (102 in Figure 1) responsive to the input device to select the music data files for the playlist based on the user selected identification data; (8) a CODEC (114 in Figure 1) to receive the selected music data files and convert the selected music data files to audio data; and (9) an audio output driver (Current Application, page 6, lines 5-11) coupled to the CODEC to receive the audio data therefrom, the audio output driver further having an output and providing analog signals to the output for connection to an audio output device.

Dependent Claims 2-11

Claim 2 is directed to the system of claim 1 wherein the data structure contains music data files having different data format types (Current Application, page 5, lines 13-28). Claim 3 is directed to the system of claim 1 wherein the data associated with the stored music data files comprises song names and the display displays the song names, the user manually generating the playlist (184 in Figure 4) by operating the user input device to select song names and the processor generating the playlist based on the selected song names. Claim 4 is directed to the system of claim 1 wherein the data associated with the stored music data files comprises metatags (Current Application, page 13, line 19 - page 14, line 28) and the display displays the metatags, the user generating the playlist (184 in Figure 4) by operating the user input device to select metatags and the processor generating the playlist based on the selected metatags. Claim 5 is directed to the system of claim 1, further comprising an associated data structure wherein the associated data comprises a plurality of data types (Current Application, page 5, lines 13-28), the processor analyzing the music data file to determine one or more associated data types and storing each of the data types for each music data file in the associated data structure in association with the music data file. Claim 6 is directed to the system of claim 5 wherein the processor selects the music data files for the playlist (184 in Figure 4) by generating an indicator to indicate a storage location in the associated data structure for an associated data type for each of the selected music data files. Claim 7 is directed to the system of claim 1 wherein the associated data comprises a plurality of data types and the user selects a desired data type using the user input device, the display displaying the user-selected data type associated with each of the plurality of music data files (Current Application, page 13, line 19 page 15, line 13). Claim 8 is directed to the system of claim 1 wherein the associated data comprises a plurality of data types and the display displays all associated data types for a user-selected one of the music data files (Current Application, page 13, line 19 page 15, line 13). Claim 9 is directed to the system of claim 1, further comprising a selection data structure wherein the playlist (184 in Figure 4) is stored for subsequent use. Claim 10 is directed to the system of claim 1 wherein the processor alters the stored playlist (184 in Figure 4) and wherein the altered playlist is stored for subsequent use. Claim 11 is directed to the system of claim 1 wherein the processor is responsive to the input device to select music data files based on user-selection of a plurality of identification

data associated with the music data files (Current Application, page 13, line 19 page 15, line 13).

Independent Claim 12

Claim 12 is directed to method for the automatic control of music selection in a hand-held portable multi-media device (Current Application, page 3, lines 2-9). The method includes: (1) storing a plurality of music data files, each music selection data file having identification data associated therewith (Current Application, page 7, line 26 - page 8, line 3); (2) sensing user operation of an input device to select identification data associated with desired music data files for the playlist (Current Application, page 9, line 16 - page 12, line 3); (3) selecting a portion of the music data files to generate the playlist based on the user selected identification data (Current Application, page 15, line 24 - page 19, line 17); (4) processing the selected music data files with a CODEC to convert the selected music data files to audio data (Current Application, page 4, line 17 - page 6, line 7); and (5) providing the audio data to an output for connection to an audio output device (Current Application, page 6, lines 5-11).

Dependent Claims 13-17

Claim 13 is directed to the method of claim 12 wherein the music data files have different data format types (Current Application, page 5, lines 13-28). Claim 14 is directed to the method of claim 12 wherein the data associated with the stored music data files comprises song names, the method further comprising displaying the song names and sensing user-operation of the input device to manually generate the playlist (184 in Figure 4) by operating the user input device to select song names wherein selecting comprises generating the playlist based on the selected song names. Claim 15 is directed to the method of claim 12 wherein the data associated with the stored music data files comprises metatags (Current Application, page 13, line 19 - page 14, line 28), the method further comprising displaying the metatags and sensing user-operation of the input device to select metatags wherein selecting comprises generating the playlist (184 in Figure 4) based on the selected metatags. Claim 16 is directed to the method of claim 12 wherein the associated identification data comprises a plurality of data types, the method further comprising analyzing the music data file to determine one or more associated data types and storing each

of the data types for each music data file in association with the music data file (Current Application, page 5, lines 13-28). Claim 17 is directed to the method of claim 12, further comprising sensing user input to select a plurality of identification data wherein selecting music data files is based on the user-selected plurality of identification data associated with the music data files (Current Application, page 5, lines 13-28).

Independent Claim 18

Claim 18 is directed to a computer-readable media that causes a processor to control of music selection in a hand-held portable multi-media device (Current Application, page 3, lines 2-9) by performing the steps of: (1) storing a plurality of music data files, each music selection data file having identification data associated wherewith (Current Application, page 7, line 26 - page 8, line 3); (2) sensing user operation of an input device to select identification data associated with desire music data files for the playlist (Current Application, page 9, line 16 - page 12, line 3); (3) selecting a portion of the music data files to generate the playlist (184 in Figure 4) based on the user selected identification data (Current Application, page 15, line 24 - page 19, line 17); (4) processing the selected music data files with a CODEC to convert the selected music data files to audio data (Current Application, page 4, line 17 - page 6, line 7); and (5) providing the audio data to an output for connection to an audio output device (Current Application, page 6, lines 5-11).

Dependent Claims 19-20

Claim 19 is directed to the computer-readable media of claim 18 wherein the data associated with the stored music data files comprises metatags (Current Application, page 13, line 19 - page 14, line 28), the computer-readable media causing the processor to perform the steps of displaying the metatags and sensing user-operation of the input device to select metatags wherein selecting comprises generating the playlist (184 in Figure 4) based on the selected metatags. Claim 20 is directed to the computer-readable media of claim 18, further causing the processor to sense user input to select a plurality of identification data and select music data files based on the user-selected plurality of identification data associated with the music data files Claim 2 is directed to the system of claim 1 wherein the data structure contains music data files having different data format types (Current Application, page 5, lines 13-28). Claim 3 is directed to the system of claim 1 wherein the data associated

with the stored music data files comprises song names and the display displays the song names, the user manually generating the playlist (184 in Figure 4) by operating the user input device to select song names and the processor generating the playlist based on the selected song names. Claim 4 is directed to the system of claim 1 wherein the data associated with the stored music data files comprises metatags (Current Application, page 13, line 19 - page 14, line 28) and the display displays the metatags, the user generating the playlist (184 in Figure 4) by operating the user input device to select metatags and the processor generating the playlist based on the selected metatags. Claim 5 is directed to the system of claim 1, further comprising an associated data structure wherein the associated data comprises a plurality of data types (Current Application, page 5, lines 13-28), the processor analyzing the music data file to determine one or more associated data types and storing each of the data types for each music data file in the associated data structure in association with the music data file. Claim 6 is directed to the system of claim 5 wherein the processor selects the music data files for the playlist (184 in Figure 4) by generating an indicator to indicate a storage location in the associated data structure for an associated data type for each of the selected music data files. Claim 7 is directed to the system of claim 1 wherein the associated data comprises a plurality of data types and the user selects a desired data type using the user input device, the display displaying the user-selected data type associated with each of the plurality of music data files (Current Application, page 13, line 19 page 15, line 13). Claim 8 is directed to the system of claim 1 wherein the associated data comprises a plurality of data types and the display displays all associated data types for a user-selected one of the music data files (Current Application, page 13, line 19 page 15, line 13). Claim 9 is directed to the system of claim 1, further comprising a selection data structure wherein the playlist (184 in Figure 4) is stored for subsequent use. Claim 10 is directed to the system of claim 1 wherein the processor alters the stored playlist (184 in Figure 4) and wherein the altered playlist is stored for subsequent use. Claim 11 is directed to the system of claim 1 wherein the processor is responsive to the input device to select music data files based on user-selection of a plurality of identification data associated with the music data files (Current Application, page 13, line 19 page 15, line 13).

GROUNDS OF REJECTION TO BE REVIEWED ON APPEAL

1.   The rejection of claims 1-5 and 7-20 under 35 U.S.C. §103(a) as being

unpatentable over Winsky et al., U.S. Patent No. 5,739,451 ("Winsky").

ARGUMENT

In an office action dated March 15, 2007 ("Office Action"), the Examiner rejected claims 1-5 and 7-20 under 35 U.S.C. §103(a) as being unpatentable over Winsky, and conditionally allowed claim 6. Although Appellant is grateful for the conditional allowance of claim 6, Appellant nonetheless continued to traverse the 35 U.S.C. §103(a) rejections of claims 1-5 and 7-20 in an Appeal Brief, filed on October 15, 2007. The Examiner issued an Examiner's Answer, on February 8, 2008. The present Reply Brief is intended to respond to the Examiner's Answer.

ISSUE 1

1.   The rejection of claims 1-5 and 7-20 under 35 U.S.C. §103(a) as being unpatentable over Winsky.

The present Reply Brief is intended to respond to the Examiner's Answer, particularly to section 10, Response to Argument, of the Examiner's Answer. In this section, the Examiner states:

> The applicant is arguing that Winsky et al. fails to disclose a playlist. The applicant states that "the current invention is directed to a creation, storage, retrieval, display, and playing of musical files represented by playlists." Clearly as seen in figures 3-5, Winsky disclose each element listed above and wherein the comparative operation is discussed in the abstract.
> The applicant places a lot of emphasis on the word "playlist" and argues the term throughout his arguments. A playlist is merely a selection of songs.

This statement reveals, perhaps more than any other statement, the failure of the Examiner to appreciate the significance of the term "playlist," and the failure of the Examiner to present a *prima facie* case for obviousness under 35 U.S.C. §103(a). As discussed in M.P.E.P. § 2142, the *KSR* decision of the Supreme Court relaxed certain rigid tests for obviousness rejections, but, at the same time, clearly increased the burden on examiners to provide substantive 35 U.S.C. § 103 rejections. As stated in M.P.E.P. § 2142, according to the *KSR* decision "[t]he key to supporting any rejection under 35 § 103 is the clear articulation of the reason(s) why

the claimed invention would have been obvious" and "the analysis supporting a rejection under 35 U.S.C. § 103 should be made explicit." As stated in M.P.E.P. § 2142: "The Federal Circuit has stated that 'rejections on obviousness cannot be sustained with mere conclusory statements; instead, there must be some articulate reasoning with some rational underpinning to support the legal conclusions of obviousness.'" Applicant's representative has never encountered a more conclusory, and incorrect, statement than: "A playlist is merely a selection of songs." The Examiner's statement would suggest that a list of songs written out on paper would constitute a playlist. However, in making this statement, the Examiner ignores the explanation of the term "playlist" in the current application and provided to the Examiner repeatedly during prosecution. The Examiner does not have the latitude to arbitrarily define terms. Because the Examiner has taken it upon himself to do so, the Examiner's obviousness-type rejection necessarily fails rudimentary standards for a *prima facie* case of obviousness. The Examiner has failed to provide a rationale for choosing to define the term "playlist" contrary to the meaning of the term explained in the current application, although, clearly, such a definition would be convenient in attempting to read the current claims onto Winsky's musical encyclopedia.

In the Appeal Brief, Applicant's representative quotes several passages from the current application, as follows:

As stated in the current application, beginning on line 20 of page 9:

> The user may simply activate the playlist to play musical tracks in a predetermined sequence shown in a playlist by pressing the selection control button 174. When a display list is first shown on the display 108, the first entry in the playlist may be automatically selected and indicated using, by way of example, reverse video.

Playlists are further described beginning on line 24 of page 15:

> If the user has selected the jukebox function, the result of decision 304 is YES. In that event, the system 100 queries the data structure 134 and extracts the titles of all existing playlists and, in step 308, the existing playlists are shown on the display 108 (see Figure 1). In decision 310, the system 100 determines whether the user has activated one or more buttons to select a playlist. If the user has selected a playlist for play, the result of decision of 310 is YES and, in step 312, the system plays the selected playlist by transferring data from the buffer 124 (or the memory 104) to the CODEC 114 in a conventional fashion. As previously noted, the musical tracks of the selected playlist may be played sequentially in the sequence originally specified by the user when creating the playlist, in a new sequence specified by the user at the present time, or in some other

fashion, such as random selection.

Clearly, a playlist is not merely a list of song titles. A playlist can be selected for play. Lists of song titles cannot. Lists of song titles cannot be played sequentially, or in any other order. Textual information stored in memory, as shown in Figure 3 of Winsky, and textual displays of song titles and artists, shown in Figures 4 and 5 of Winsky, do not teach or suggest a playlist that can be invoked to sequentially, or in any other order, render digital files into music.

Winsky does not teach, disclose, mention, or suggest playlists or playlist-based interfaces for portable audio devices that render audio files for listening by users of the devices. Instead, Winsky discloses a hand-held electronic music encyclopedia which stores snippets and selections of various songs, and provides an interface to allow a user to attempt to identify one particular song based on a title, lyrics, relative note or pitch values, and other information. Winsky clearly describes operation of Winsky's disclosed device in Winsky's Abstract. Winsky's device displays a list of song titles. A user can select one title from the list. By selecting the song title, the user invokes display of the lyrics for the selected song, as well as playing a small segment of the selected song. Nowhere does Winsky teach or suggest that a user can select the list of song titles for sequential playing of the corresponding songs, or playing of the songs in any other order. *In fact, Winsky does not even disclose the capability of playing a single song, in its entirely.* Indeed, Winsky does disclose display of a list of song titles. But, as repeatedly pointed out by Applicant's representative, a list of song titles does not correspond to the meaning of the term playlist as explained and used in the current application, and as well understood by those familiar with hand-held music-rendering devices.

The Examiner states:

> However, a playlist can also contain a single song, if a user wishes to only
> have a single song in his or her playlist.

While a playlist may contain a single song at any given time, a playlist may also accommodate multiple songs at other times, depending on a user's wishes. A playlist can be edited, created, and updated, as described beginning on line 24 of page 9 of the current application. A single, displayed song title does not provide such functionality. A playlist is not simply a text description of song titles. *A playlist includes a digitally encoded data structure as well as both hardware components and software that allow a playlist to be*

played, edited, and created by a user.

The Examiner states:

> The applicant argues that Winsky et al. do not disclose the term "playlist".
> However, the term is define as a list of songs and Winsky et al. provides
> the equivalent. It is not necessary to use the same terminology if the same
> or the equivalent is provided.

Again, the Examiner's reasoning is circular, depending entirely on the Examiner's arbitrary definition of the term "playlist," contrary to the meaning of the term as explained in the current application and as well known to those who design, develop, and use hand-held music-rendering devices.

The Examiner states:

> Also it is clear that Winsky et al. provides the storage of multiple songs,
> which clearly indicates that Winsky et al. is capable of playing and listing
> multiples songs, wherein any order would provide a sequence of songs to
> be played or played.

Again, this is a completely conclusory statement. Winsky nowhere teaches or suggests that a user can invoke automatic playing of multiple songs corresponding to a list of song titles. Just because, for example, I can import a series of music files into a directory on a computer does not imply that I can invoke rendering of the music files, or rendering of the files sequentially or in other predefined orders. To do so, music-rendering software providing those capabilities is needed. Winsky does not disclose such capabilities, and Winsky's device is directed to facilitating recollection of songs, rather than being used as a portable music player. Winsky does not even disclose the capability of playing one entire song, instead referring to segments of songs that are played to assist a user in recollecting and identifying a song.

The Examiner states:

> The applicant states "the term "playlist" is a well-understood . . . term in
> the field . . . such as the Apple iPod device." This submission alone states
> that the present invention provides nothing new, wherein the current
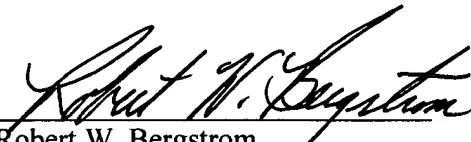> claims can be rejected using the Apple iPod device.

Applicant's representative suggests that the Examiner review the filing data of the current application and release date of the Apple iPod, prior to making such statements.

The current application and current claims are directed to creation and use of playlists on portable music-playing devices. Winsky does not teach, mention, or even

suggest playlists. Winsky's disclosed device is not designed as a music-playing device for playing songs and other musical compositions, but is instead designed as a music encyclopedia and game platform. Winsky does not anticipate any of the current claims.

Applicant respectfully submits that all statutory requirements are met and that the present application is allowable over all the references of record. Therefore, Applicant respectfully requests that the present application be passed to issue.

Respectfully submitted,
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